

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KIP VAN STEENBURG

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Appeal 2006-1865  
Application 09/660,433<sup>1</sup>  
Patent 5,802,641  
Technology Center 3600

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Decided: April 13, 2007

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*Before:* BRADLEY R. GARRIS, FRED E. MCKELVEY, and  
ALLEN R. MACDONALD, *Administrative Patent Judges.*

MACDONALD, *Administrative Patent Judge.*

DECISION ON APPEAL

AFFIRMED

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<sup>1</sup> Application filed September 7, 2000, seeking to reissue U.S. Patent 5,802,641 issued September 8, 1998, based on application 08/813,708, filed March 7, 1997. The real party in interest is The OR Group, Inc. (Br. 1).

## I. STATEMENT OF CASE

1. Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 14-100 entered May 21, 2002. We have jurisdiction under 35 U.S.C. § 6(b).

2. Independent claim 14 under appeal reads as follows:

Claim 14. A leg positioning apparatus comprising  
a support device,

a leg cradle coupled to the support device and movable about a first plurality of axes relative to the support device,

a clamping device coupling the support device to a mounting device, the clamping device being configured to clamp the motion of the support device relative to the mounting device and to release the support device for rotative movement relative to the mounting device about a second plurality of axes, the leg cradle being movable about the first plurality of axes when the support device is clamped against movement about the second plurality of axes,

an actuator device configured to move the clamping device to selectively clamp and release the support device relative to the mounting device, and

an operator device remote from the clamping device and remote from the actuator device, the operator device being operatively coupled to the actuator device, the operator device being configured to operate the actuator device.

3. A copy of the claims 14-100 under appeal is set forth in the Claim Appendix of Appellant's Brief.<sup>2</sup>

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<sup>2</sup> Appellant's grouping of claims at pages 2-3 of the Brief contains several minor errors. Claim "1000" will be read as claim "100". Claims 86-87 and 96-97 will be grouped with claims 85 and 95 from which they depend respectively.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

4. The Examiner rejected claims 14-100 under 35 U.S.C. § 251 as being an improper recapture of surrendered subject matter (Supplemental Examiner's Answer 2-5). Claims 1-13 are not rejected.

5. With respect to the rejection under 35 U.S.C. § 251, the panel affirms the decision of the Examiner.

### ISSUE

The sole issue before the Board is whether Appellant has established that the Examiner erred in rejecting claims 14-100 under 35 U.S.C. § 251 based on recapture.

### III. FINDINGS OF FACT

The following findings of fact are supported by a preponderance of the evidence.

#### A. *The Invention*

1. Appellant invented (U.S. Patent 5,802,641, Abstract):

A leg holder system for simultaneously positioning in the abduction and lithotomy dimensions including a support device for supporting a leg cradle; a clamping device for mounting the proximate end of the

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

support device to a mounting device having a first axis and selectively clamping and releasing motion of the support device about the first axis and about a second axis transverse to the first axis. An actuator device for actuating the clamp to selectively clamp and release simultaneously the support device and the mounting device; and an operator device remote from the clamping device and actuator device for operating the actuator device to enable the support device to move simultaneously about the first and second axis in both the lithotomy and abduction dimensions.

*B. Prosecution history of the original application*

2. The patent sought to be reissued is based on Application 08/813,708, filed March 7, 1997 (“original application”).

3. As filed, the original application contained claims 1-13 including representative independent claim 1 which is reproduced below (claim 1 as filed ended with the word “and”):

1. A leg holder system for simultaneous positioning in the abduction and lithotomy dimension comprising:

a support device for supporting a leg cradle;

a clamping device for mounting the proximate end of said support device to a mounting device having a first axis and selectively clamping and releasing motion of said support device about said first axis and about a second axis transverse to said first axis;

an actuator device for actuating said clamp to selectively clamp and release, simultaneously, said support device and said mounting device;

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

an operator device remote from said clamping device and actuator device for operating said actuator device to enable said support device to move simultaneously about both said first and said second axes in the abduction and lithotomy dimensions; and

4. On November 14, 1997, the Examiner entered a Non-Final Office Action (“Non-Final Action”).
5. Claims 1-13 were rejected on various grounds.
6. Claims 1-13 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite.
7. Claims 1, 4, 7, and 12, were rejected under 35 U.S.C. § 102(b) as being unpatentable over Klevstad, U.S. Patent 4,426,071.
8. Klevstad is prior art under 35 U.S.C. § 102(b).
9. The Examiner indicated that dependent claims 2, 3, 5, 6, 8-11, and 13, contained allowable subject matter, but depending from a rejected base claim.
10. On February 17, 1998, Appellant filed an Amendment (“the Amendment”) responding to the Examiner's First Office Action.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

11. The Amendment amended claims 1 and 12 which are reproduced below (matter underlined added by the Amendment and matter in [brackets] deleted by the Amendment):

1. A leg holder system for simultaneous positioning in [the] an abduction dimension and a lithotomy dimension comprising:

a support device, having a longitudinal axis, for supporting a leg cradle;

a clamping device for mounting [the] a proximate end of said support device to a mounting device having a first axis transverse to said longitudinal axis and selectively simultaneously clamping and releasing motion of said support device about said first axis and about a second axis transverse to both said first axis and said longitudinal axis, said support device fixed in said clamping device from rotation about said longitudinal axis;

an actuator device for actuating said clamping device to simultaneously selectively clamp and release [, simultaneously,] said support device and said mounting device; and

an operator device remote from said clamping device and said actuator device for operating said actuator device to enable said support device to move [simultaneously] jointly about both said first and said second axes in the abduction and lithotomy dimensions [; and] .

12. The leg holder system of claim 1 in which said support device includes a cradle bracket for mounting a leg cradle spaced from [the axis] said longitudinal axis of said support means.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

12. After entry of the Amendment, the application claims were 1-13.

13. In the Amendment, Appellant presented extensive argument with respect to the patentability of amended claim 1.

14. Appellant arguments (see below) addressed at least the following seven limitations of Appellant's amended claim 1:

- (1) A supporting device moving jointly about first and second axes;
- (2) The support device having a longitudinal axis;
- (3) The first and second axes are transverse to the longitudinal axis; and
- (4) The first and second axes are transverse to each other;
- (5) Simultaneously selectively clamping and releasing said support device about the first and second axes;
- (6) The support device is fixed from rotation about its longitudinal axis.
- (7) Simultaneously selectively clamping and releasing the supporting device and a mounting device.

Limitations (2), (3), (5), and (6), were added by the Amendment. Limitations (1), (4), and (7), are found in the originally filed claim 1.

15. In the Amendment at page 3, Appellant argued the following as to the amended claims:

Because Klevstad does not teach an actuator that simultaneously selectively clamps and releases to enable a support device to move jointly about a first and second axes that are transverse

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

to each other and to the longitudinal axis of the support device and because Klevstad does not teach a support device that is fixed from rotation about its own longitudinal axis, Klevstad does not anticipate applicant's claimed invention.

The argument directly above addressed Finding of Fact 14 limitations (1)-(6) found in Appellant's amended claim 1.

16. In the Amendment at pages 3-4, Appellant further argued the following as to the amended claims:

The applicant's claimed invention recites a leg holder system for simultaneous positioning in the abduction (horizontal) and lithotomy (vertical) dimensions having a support device with a longitudinal axis (80) for supporting a leg cradle, a clamping device for mounting the proximate end of the support device to a mounting device having a first axis (36) transverse to the longitudinal axis and simultaneously clamping or releasing the motion of the support device about a second axis (72) which is transverse to both the first and longitudinal axes, the support device being fixed from rotation about its longitudinal axis.

An actuator device actuates the clamping device to simultaneously, selectively clamp and release jointly, simultaneously the support device and the mounting device.

An operator device, remote from the clamping device and actuator device, operates the actuator device to enable the support device to move jointly about both the first and second axes in the abduction and lithotomy dimensions.

The argument directly above again addressed Finding of Fact 14 limitations (1)-(6) and also addresses limitation (7) found in Appellant's amended claim 1.



Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

17. In the Amendment at page 4, Appellant additionally argued the following as to the amended claims:

Thus, the applicant's claimed invention enables the support device to be moved simultaneously about both the horizontal and vertical axes in a single, fluid motion by a single actuator. This not only allows the motion of the support device to closely mimic the natural motion of the hip and more comfortably accommodate the patient, but further allows the attendant or doctor to quickly, efficiently and effortlessly adjust the patient's legs to permit the doctor access to the patient without entering the sterile area.

In contrast, Klevstad teaches an actuator device (43) which allows rotational movement of a support device about its own longitudinal axis and rotation about a second, horizontal axis (e.g. pin 36) transverse to the longitudinal axis to enable vertical movement of the support device. However, in order for Klevstad to further allow the support device to move horizontally about a vertical axis (e.g. vertical shaft 32) transverse to both the longitudinal and second axes, Klevstad requires adjustment of a second actuator (locking pin 34).

Klevstad does not teach an actuator device that simultaneously selectively clamps and releases the support device and the mounting device to allow movement of the support device jointly about first and second axes transverse to the longitudinal axis of the support device and to each other.

The argument directly above again addressed limitations (1)-(5) and (7).

18. In the Amendment at page 5, Appellant argued the following as to the amended claims:

The actuator of Klevstad allows movement of the support device about a first axis, allowing vertical movement, and about a its [sic] own longitudinal axis.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

In stark contrast, the applicant claims, as amended, a support device which is fixed from rotation about its longitudinal axis by a fixed or force fit within the mounting device.

The argument directly above again addressed limitations (2) and (6).

19. In the Amendment at page 5, Appellant argued the following as to the amended claims:

Klevstad does not teach a single actuator which simultaneously releases the support device to move about first and second axes which are transverse to each other and to the longitudinal axis of the support device.

The actuator (43) of Klevstad only releases the support device to allow movement about pin 36 and about the longitudinal axis (39) of the support device. In order to enable movement about a second axis transverse to the first axis and the longitudinal axis of the support device, locking bolt 34 must also be adjusted.

Thus, Klevstad requires the adjustment of two actuators in order to allow movement about two axes transverse to each other and to the longitudinal axis of the support device.

In stark contrast, the applicant claims a single actuator which simultaneously clamps or releases the mounting device and the support device, fixed from rotation about its longitudinal axis within the mounting device, to enable the support device to move jointly about both the first and second axes.

The argument directly above again addressed limitations (1)-(7).

20. On March 30, 1998, a Notice of Allowability was mailed which stated that pending claims 1-13 were allowed.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

21. U.S. Patent 5,802,641 issued September 8, 1998, based on the original application and contained claims 1-13.

*C. Prosecution of reissue application*

22. Appellant filed reissue application 09/660,433 on September 7, 2000, seeking to reissue U.S. Patent 5,802,641.

23. Appellant presented original patent claims 1-13 along with new reissue application claims 14-100 for consideration.

24. Ultimately, reissue claims 14-100 were rejected.

25. Claims 1-13 are neither rejected nor indicated as allowable.

26. Reissue application claims 14-100 are before the Board in the appeal.

27. A copy of the claims 14-100 under appeal is set forth in the Claim Appendix of Appellant's Brief.

*D. Examiner's Rejection*

28. The Examiner has rejected reissue application claims 14-100 under 35 U.S.C. § 251 maintaining that the claims seek to "recapture" subject matter

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

surrendered in obtaining allowance of the claims which appear in the patent sought to be reissued.

29. The Examiner based the rejection of claims 14-100 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 102(b) over the Klevstad prior art patent, Appellant made three *significant* amendments to originally filed claim 1:

(1) *First*, Appellant amended rejected independent claim 1 to add the requirements that the support device have “a longitudinal axis”, and that first and second axes are “transverse to . . . said longitudinal axis”; amended original application claim 1 ultimately became patent claim 1.

(2) *Second*, Appellant also amended rejected independent claim 1 to add the requirement of “simultaneously” selectively clamping and releasing motion of said support device about said first and second axes.

(3) *Third*, Appellant also amended rejected independent claim 1 to add the requirement of the support device being “fixed in said clamping device from rotation about said longitudinal axis”.

30. In addition, the Examiner based the rejection of claims 14-100 on the grounds that when faced in the original application with a rejection under

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

35 U.S.C. § 112 and a rejection under 35 U.S.C. § 102(b) over the Klevstad prior art patent, Appellant made two *insignificant* amendments to originally filed claim 1:

(1) *First*, Appellant amended rejected independent claim 1 to provide proper antecedent basis to the originally claimed requirement of “abduction and lithotomy dimensions”.

(2) *Second*, Appellant amended rejected independent claim 1 to grammatically clarify the originally claimed requirement of “selectively clamp and release, simultaneously, said support and said mounting device”.

31. Finally, the Examiner based the rejection of claims 14-100 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 102(b) over the Klevstad prior art patent, Appellant made extensive *significant* arguments with respect to amended claim 1 (Examiner’s Answer 5:3). (See also the Findings of Fact 14-19 *supra* with respect to Appellant’s arguments regarding claim limitations (1)-(7).)

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

32. The Examiner reasoned as follows (Final Office Action entered May 21, 2002, pages 2-3):<sup>3</sup>

The applicant is attempting to claim the supporting device without reference to a longitudinal axis and a clamping device having an axis transverse to the longitudinal axis. The applicant is also attempting to drop out any reference to a clamping device that can simultaneously clamp and release the supporting device relative to the clamping device about the first and second (longitudinal and transverse) axes. These limitations were expressly added during the prosecution of the 08/813,708 application in order to define over the subject matter disclosed in the Klevstad patent. These [sic] inclusion of these limitations in the original claims 1 to 13 were also relied upon by the applicant as part of the arguments used to secure an allowance over the Klevstad patent.

33. The Examiner further reasoned (Final Office Action 4):

The [reissue] independent claims therefore removes or broadens almost all the limitations added to old claim 1 during the prosecution in order to define over the Klevstad reference, these limitations were referred to and relied upon extensively in the applicant's arguments as defining over the Klevstad patent. Since these limitations were added in order to secure an allowance, any attempt to now drop them out altogether is an attempt at recapture.

34. Additionally, the Examiner reasoned (Final Office Action 4):

This is supported by the applicant's declaration, in which it is stated clearly that the mistake sought for correction was limiting claim 1 to a supporting device with a longitudinal axis and the clamping device

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<sup>3</sup> The parenthetical “(longitudinal and traverse)” is in error as the clamping is about two axis which are transverse to each other and to the longitudinal axis. The parenthetical should read “(transverse to each other)”.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

having an axis transverse to the longitudinal axis. These limitations were added during the prosecution of claim 1 in the original application, and were not present in the claims as originally filed.

35. The record supports the Examiner's findings with respect to what limitations do not appear in reissue application claims 14-100 which were present in claim 1 of the original application, as allowed.

36. An Examiner's Answer ("the Answer") was entered March 25, 2003.

37. A Supplemental Examiner's Answer ("the Supplemental Answer") was entered April 20, 2005.

38. In the Supplemental Answer at page 3, the Examiner cited the following one of Appellant's extensive *significant* arguments made with respect to amended claim 1 to overcome the Klevstad prior art patent.

Klevstad does not teach an actuator device that simultaneously selectively clamps and releases the support device and the mounting device to allow movement of the support device jointly about first and second axes transverse to the longitudinal axis of the support device and to each other.

39. The Examiner reasoned (*see* Supplemental Answer 3):

Hence, from the specification, the construction of the claim, the amendment and the accompanying arguments, it is clear that the invention was claimed (as amended) to selectively clamp and selectively release the support device and the mounting device to control movement, or lack thereof, of the support device simultaneously (i.e., occurring at the same time or concurrently) about

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

first and second axes transverse to the longitudinal axis of the support device and to each other.

In the rejection of the reissue application, the examiner had rejected the reissue claims by noting that the Applicant was attempting to remove said limitations, particularly the reference to the transverse axes and simultaneity of movement or lack thereof relative to said transverse axes (see, Application 09/660,433), paper no. 11, p. 2, last paragraph.



Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

#### IV. DISCUSSION – REJECTION UNDER 35 U.S.C. § 251

##### *A. Recapture Principles*

(1)

##### *The statute*

The reissue statute expressly permits a patentee to correct an error thus permitting patentee to obtain reissue claims broader than the originally issued patent claims at any time within two (2) years from the date the original patent issues. More particularly, 35 U.S.C. § 251, ¶¶ 1 and 4, provide in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(2)  
*Recapture is not an error  
within the meaning of 35 U.S.C. § 251*

What has become known as the “recapture rule,” prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

If a patentee attempts to “recapture” what the patentee previously surrendered in order to obtain allowance of original patent claims, that “deliberate withdrawal or amendment ... cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the [subject] matter withdrawn.” *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993), quoting from *Haliczer v. United States*, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966).<sup>4</sup> *See also Hester Industries Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998).

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<sup>4</sup> *Haliczer* is binding precedent. *See South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982) (in banc) (decisions of the former U.S. Court of Customs and Patent Appeals and former U.S. Court of Claims decisions are binding precedent).

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(3)  
*In re Clement*

The Federal Circuit's opinion in *Clement* discusses a three-step test for analyzing recapture.

*Step 1* involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims. The Federal Circuit reasoned that a reissue application claim deleting a limitation or element from a patent claim is broader as to that limitation's or element's aspect. 131 F.3d at 1468, 45 USPQ2d at 1164.

*Step 2* involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter. 131 F.3d at 1468-69, 45 USPQ2d at 1164. In this respect, review of arguments and/or amendments during the prosecution history of the application, which matured into the patent sought to be reissued, is appropriate. In reviewing the prosecution history, the Federal Circuit observed that "[d]eliberately canceling or amending a claim in an effort to overcome a [prior art] reference strongly suggests that the Appellant admits that the scope of the claim before cancellation or amendment is unpatentable. 131 F.3d at 1469, 45 USPQ2d at 1164.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

*Step 3* is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim. *Id.* The following principles were articulated in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165:

*Substep (1)*: if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim;

*Substep (2)*: if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible;

*Substep (3)*: if the reissue claim is broader in some aspects, but narrower in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

(4)

*North American Container*

In *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005), the Federal Circuit had occasion to further address *Substep (3)(a)* of *Clement*.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

*North American Container* involved a reissue patent, which had been held invalid by the U.S. District Court for the Northern District of Texas. The district court bottomed its invalidity holding based on a violation of the recapture rule. During prosecution of an application for patent, an examiner rejected the claims over a combination of two prior art references: Dechenne and Jakobsen. To overcome the rejection, *North American Container* limited its application claims by specifying that a shape of “inner walls” of a base of a container was “generally convex.” *North American Container* convinced the examiner that the shape of the base, as amended, defined over “both the Dechenne patent, wherein the corresponding wall portions 3 are *slightly concave* ... and the Jakobsen patent, wherein the entire reentrant portion is clearly *concave in its entirety*.” 415 F.3d at 1340, 75 USPQ2d at 1549. After a patent issued containing the amended claims, *North American Container* filed a reissue application seeking reissue claims in which (1) the language “inner wall portions are generally convex” was eliminated, but (2) the language “wherein the diameter of said re-entrant portion is in the range of 5% to 30% of the overall diameter of said side wall” was added. Thus, the claim sought be reissued was broader in some aspects and narrower in other aspects.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

The Federal Circuit, applying the *Clement* three-step test, held that the reissue claims were broader in scope than the originally-issued claims in that they no longer require the “inner walls” to be “generally convex.” The Federal Circuit further found that the broadened aspect (i.e., the broadened limitation) “relate[d] to subject matter that was surrendered during prosecution of the original-filed claims.” 415 F.3d at 1350, 75 USPQ2d at 1557. The Federal Circuit observed “the reissue claims were not narrowed with respect to the ‘inner wall’ limitation, thus avoiding the recapture rule.” The Federal Circuit stated:

[t]hat the reissue claims, looked at as a whole, may be of “intermediate scope” is irrelevant. . . . [T]he recapture rule is applied on a limitation-by-limitation basis, and ... [North American Container’s] deletion of the “generally convex” limitation clearly broadened the “inner wall” limitation.

*Id.* Thus, the Federal Circuit in *North American Container* further refined Substep (3)(a) of *Clement*: “broader in an aspect germane to a prior art rejection” means broader with respect to a *specific* limitation (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and (2) eliminated in the reissue application claims.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(5)  
*Ex parte Eggert*

The opinion in *Ex parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003), issued as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit's *North American Container* decision. In *Eggert*, a majority stated that “[i]n our view, the surrendered subject matter is the outer circle of Drawing 1 [the rejected claim prior to the amendment that resulted in the claim being issued] because it is the subject matter Appellant conceded was unpatentable.” 67 USPQ2d at 1717. The majority further held that “in our view” subject matter narrower than the rejected claim but broader than the patented claim is not barred by the recapture rule. *Id.* The majority explained that if the finally rejected claim was ABC and the patent claim was ABCDEF, there would be recapture for ABC or anything broader than ABC, but not for claims directed to ABCX, ABCD<sub>Br</sub>, ABCEF, or A<sub>Br</sub>BCDEF, because those claims would be narrower than the finally rejected claim ABC. 67 USPQ2d at 1717. In its opinion, the majority recognized that the Federal Circuit had held that “the mere presence of narrowing limitations in the reissue claim is

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

not necessarily sufficient to save the reissue claim from the recapture rule.” 67  
USPQ at 1729.

Board of Patent Appeals and Interferences Standard Operating Procedure 2  
(Revision 6) (August 10, 2005) mandates that a published precedential opinion of  
the Board is binding on all judges of the Board *unless* the views expressed in an  
opinion in support of the decision, among a number of things, are inconsistent with  
a decision of the Federal Circuit. In our view, the majority view in *Eggert* is  
believed to be inconsistent with the subsequent Federal Circuit decision in *North  
American Container* with respect to the principles governing application of  
Substep (3)(a) of *Clement*.

The *Eggert* majority’s analysis is believed to be consistent with *North  
American Container* in that the majority applied the three-step framework analysis  
set forth in applicable Federal Circuit opinions, *e.g.*, (1) *Pannu v. Storz Instruments  
Inc.*, 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001); (2)  
*Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 and (3) *Hester*, 142 F.3d at 148,  
46 USPQ2d at 1648-49. However, the *Eggert* majority also held that the  
surrendered subject matter was the rejected claim only rather than the amended  
portion of the issued claim. 67 USPQ2d at 1717. At a similar point in the



Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

recapture analysis, *North American Container* has clarified the application of the three-step framework analysis. *North American Container* holds that the “inner walls” limitation (a portion of the issued claim that was added to the rejected claim by amendment) was “subject matter that was surrendered during prosecution of the original-filed claims.” 415 F.3d at 1350, 75 USPQ2d at 1557.

It is believed that the Substep (3)(a) rationale of the *Eggert* majority (1) is not consistent with the rationale of the Federal Circuit in *North American Container* and (2) should no longer be followed or be applicable to proceedings before the USPTO.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(6)

*What subject matter is surrendered?*

In a case involving Substep (3)(a) of Step 3 of *Clement*, what is the subject matter surrendered?

Is it

- (1) the subject matter of an application claim which was amended or canceled or
- (2) the subject matter of an application claim which was amended or canceled *and*, on a limitation-by-limitation basis, the territory falling between the scope of
  - (a) the application claim which was canceled or amended and
  - (b) the patent claim which was ultimately issued?

We believe *North American Container* stands for the proposition that it is (2) and not (1). Accordingly, we hold that it is (2).

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(7)

*Clement principles are not per se rules*

Our reading of our appellate reviewing court's recapture opinions, as a whole, suggests that the *Clement* steps should not be viewed as per se rules. For example, we note the following in *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1164:

Although the recapture rule does not apply in the absence of evidence that the Appellant's amendment was "an admission that the scope of that claim was not in fact patentable," *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available," *Ball [Corp. v. United States]*, 729 F.2d at 1436, 221 USPQ at 294. Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the Appellant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. *See Mentor [Corp. v. Coloplast, Inc.]*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball*, 729 F.2d at 1438, 221 USPQ at 296; *Seattle Box Co.*, 731 F.2d at 826, 221 USPQ at 574 (declining to apply the recapture rule in the absence of evidence that the Appellant's "amendment ... was in any sense an admission that the scope of [the] claim was not patentable"); *Haliczer [v. United States]*, 356 F.2d at 545, 148 USPQ at 569 (acquiescence in the rejection and acceptance of a patent whose claims include the limitation added by the Appellant to distinguish the claims from the prior art shows intentional withdrawal of subject matter); *In re Willingham*, 282 F.2d 353, 354, 357, 127 USPQ 211, 213, 215 (CCPA 1960) (no intent to surrender where the Appellant canceled and replaced a claim without an intervening action by the examiner). Amending a claim "by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

canceled and replaced by a new claim including that limitation.” *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956). [Footnote and citations to the CCPA reports omitted.]

(8)

*Allocation of burden of proof*

What is the proper allocation of the burden of proof in ex parte examination?

For reasons that follow, we hold that an examiner has the burden of making out a prima facie case of recapture. The examiner can make out a prima facie case of recapture by establishing that the claims sought to be reissued fall within Substeps (1) or 3(a) of Step 3 of *Clement*.

For reasons that follow, we also hold that once a prima facie case of recapture is established, the burden of persuasion then shifts to the Appellant to establish that the *prosecution history* of the application, which matured into the patent sought to be reissued, establishes that a surrender of subject matter did not occur (or that the reissue claims are materially narrowed).

As will become apparent, our rationale parallels the practice in determining whether subject matter is surrendered when a doctrine of equivalents analysis occurs in infringement cases.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(9)  
*Burden of proof analysis*

Our analysis begins with an observation made by our appellate reviewing court in *Hester*, 142 F.3d at 1481-82, 46 USPQ2d at 1649:

[A]s recognized in *Ball*, the recapture rule is based on principles of equity<sup>5</sup> and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 USPQ at 296. Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, [520 U.S. 17, 33,] 117 S. Ct. 1040, 1051[, 41 USPQ2d 1865, 1873] (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. See *id.*

*Hester* argues that an analogy cannot be made with prosecution history estoppel because the reissue procedure and prosecution history estoppel are the antithesis of one another--reissue allows an expansion of patent rights whereas prosecution history estoppel is limiting. However, *Hester's* argument is unpersuasive. The analogy is not to the broadening aspect of reissue. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.

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<sup>5</sup> The reissue statute has been characterized as being remedial in nature, based on fundamental principles of equity and fairness and should be construed liberally. *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (in banc); *In re Willingham*, 282 F.2d 353, 354-55, 127 USPQ 211, 214 (CCPA 1960). Nevertheless, fairness to the public must also be considered. As stated in *Mentor*, "the reissue statement cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." 998 F.2d at 996, 27 USPQ2d at 1525.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

This court earlier concluded that prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can arise by way of amendments to avoid prior art. *See, e.g., Texas Instruments, Inc. v. International Trade Comm'n*, 988 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993).

*See also* Judge Michel's opinion concurring-in-part and dissenting-in-part in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 602, 56 USPQ2d 1865, 1899 (Fed. Cir. 2000) (Festo I), *vacated and remanded*, 535 U.S. 722, 122 S. Ct. 1831, 62 USPQ2d 1705 (2002) (Festo II)<sup>6</sup> (Michel, J.):

[T]he law of prosecution history estoppel has developed with equal applicability to reissue patents and original patents whose claims were amended during prosecution. By at least 1879, the Supreme Court recognized that the process of obtaining a reissue patent precluded the patentee from recapturing that which he had disclaimed (i.e., surrendered), through the reissuance process.

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<sup>6</sup> The "Festo" convention used in this opinion is:

Festo I is the original in banc decision of the Federal Circuit.

Festo II is the decision of the Supreme Court.

Festo III is the decision of the Federal Circuit on remand.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(10)

*Relevance of prosecution history*

“Surrendered subject matter” is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002) (Festo II):

The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes. When, however, the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be deemed equivalent to the literal claims of the issued patent. On the contrary, “[b]y the amendment [the patentee] recognized and emphasized the difference between the two phrases[,] ... and [t]he difference which [the patentee] thus disclaimed must be regarded as material.” *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-37, 62 S. Ct. 513, 518-19 [52 USPQ 275, 279-80] (1942).

Festo II goes on to comment, 535 U.S. at 737-41, 122 S. Ct. at 1840-42, 62 USPQ2d at 1712-14:

[Prosecution history estoppel’s] reach requires an examination of the subject matter surrendered by the narrowing amendment. [A] complete bar [would avoid] this inquiry by establishing a per se rule; but that approach is inconsistent with the purpose of applying the estoppel in the first place—to hold the inventor to the representations

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

made during the application process and to the inferences that *may reasonably* be drawn from the amendment (emphasis added).

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A patentee's decision to narrow his claims through amendment *may be presumed to be a general disclaimer of the territory between the original claim and the amended claim*. *Exhibit Supply*, 315 U.S., at 136-137, 62 S. Ct. 513 ("By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference"). There are some cases, however, where the amendment *cannot reasonably be viewed as surrendering* a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases *the patentee can overcome the presumption* that prosecution history estoppel bars a finding of equivalence (emphasis added).

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When the patentee has chosen to narrow a claim, *courts may presume* the amended text was composed with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed. In those instances, however, *the patentee still might rebut the presumption* that estoppel bars a claim of equivalence. The patentee must show that at the time of the amendment one skilled in the art *could not reasonably* be expected to have drafted a claim that would have literally encompassed the alleged equivalent (emphasis added).



Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

The same policy considerations that prevent a patentee from urging equivalents within what the Supreme Court refers to as “surrendered territory” should prima facie prohibit the patentee from being able to claim subject matter within the surrendered territory in reissue. Accordingly, the “surrendered subject matter” that may not be recaptured through reissue should be *presumed* to include subject matter broader than the patent claims in a manner directly related to (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and (2) limitations argued to overcome a patentability rejection without amendment of a claim. These presumptions are believed to place practical and workable burdens on examiners and Appellant.

(11)

*Admissible evidence in rebuttal showing*

As in the case of surrender when applying the doctrine of equivalents, a reissue Appellant should have an opportunity to rebut any prima facie case made by an examiner.

What evidence may an Appellant rely on to rebut any prima facie case of recapture?

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

We hold that the admissible rebuttal evidence generally should be limited to (1) the prosecution history of the application which matured into the patent sought to be reissued and (2) showings related to what was known by a person having ordinary skill in the art at the time an amendment was made. Nevertheless, we will not attempt to divine, at this time, all evidence that might be relevant. As with other issues that come before the USPTO, such as obviousness and enablement, the evidence to be presented will vary on a case-by-case basis, as will the analysis of that evidence.

“It is clear that in determining whether ‘surrender’ of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent.” *Kim v. Conagra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006). Thus, we also hold that an Appellant must show that at the time the amendment was made, an “objective observer” could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered (or that an “objective observer” would view the reissue claims as materially narrowed). The showing required to be made by Appellant is consistent with the public notice

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

function of claims. Nevertheless, some limited extrinsic evidence may be relevant. However, extrinsic evidence unavailable to an “objective observer” at the time of the amendment is not relevant to showing that an “objective observer” could not reasonably have viewed the subject matter as having been surrendered. Limiting the nature of the admissible evidence is believed to be consistent with the Federal Circuit’s decision on remand following Festo II. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1367, 68 USPQ2d 1321, 1326 (Fed. Cir. 2003), *cert. denied*, 541 U.S. 988 (2004) (Festo III).

On remand, the Federal Circuit notes (*Id.* at 1367-70, 68 USPQ2d at 1326-29):

[W]e reinstate our earlier holding that a patentee’s rebuttal of the *Warner-Jenkinson* presumption is restricted to the evidence in the prosecution history record. *Festo* [I], 234 F.3d at 586 & n.6; *see also Pioneer Magnetics*, 330 F.3d at 1356 (stating that only the prosecution history record may be considered in determining whether a patentee has overcome the *Warner-Jenkinson* presumption, so as not to undermine the public notice function served by that record). If the patentee successfully establishes that the amendment was not for a reason of patentability, then prosecution history estoppel does not apply.

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. . . By its very nature, objective unforeseeability depends on underlying factual issues relating to, for example, the state of the art and the understanding of a hypothetical person of ordinary skill in the

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

art at the time of the amendment. Therefore, in determining whether an alleged equivalent would have been unforeseeable, a district court may hear expert testimony and consider other extrinsic evidence relating to the relevant factual inquiries.

. . . As we have held in the *Warner-Jenkinson* context, that reason should be discernible from the prosecution history record, if the public notice function of a patent and its prosecution history is to have significance. *See id.* at 1356 (“Only the public record of the patent prosecution, the prosecution history, can be a basis for [the reason for the amendment to the claim]. Otherwise, the public notice function of the patent record would be undermined.”); *Festo [I]*, 234 F.3d at 586 (“In order to give due deference to public notice considerations under the *Warner-Jenkinson* framework, a patent holder seeking to establish the reason for an amendment must base his arguments solely upon the public record of the patent’s prosecution, i.e., the patent’s prosecution history. To hold otherwise--that is, to allow a patent holder to rely on evidence not in the public record to establish a reason for an amendment--would undermine the public notice function of the patent record.”). Moreover, whether an amendment was merely tangential to an alleged equivalent necessarily requires focus on the context in which the amendment was made; hence the resort to the prosecution history. Thus, whether the patentee has established a merely tangential reason for a narrowing amendment is for the court to determine from the prosecution history record without the introduction of additional evidence, except, when necessary, testimony from those skilled in the art as to the interpretation of that record.

. . . When at all possible, determination of the third rebuttal criterion should also be limited to the prosecution history record. . . . We need not decide now what evidence outside the prosecution history record, if any, should be considered in determining if a patentee has met its burden under this third rebuttal criterion.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

We interpret Festo III to generally, perhaps effectively, limit the admissible rebuttal evidence to the prosecution history record and extrinsic evidence related to the knowledge of the hypothetical person of ordinary skill in the art at the time of the amendment. Admitting evidence not available to the public, such as an affidavit of an attorney giving mental impressions from the attorney who made the amendment, would undermine the public notice function of the patent and its prosecution history.

(12)

*Materially Narrowed in Overlooked Aspects*

When reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

The Federal Circuit in *North American Container* characterized the second and third steps in applying the recapture rule as determining “whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution” and “whether the reissued claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

recapture rule.” 415 F.3d at 1349, 75 USQ2d at 1556 (emphases added), citing for authority *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600. The language “materially narrowed in other respects” relates for comparison back to the earlier recited “broader aspects of the reissued claims” (i.e., surrendered subject matter). Thus, by using the phrase “in other respects” to modify “materially narrowed,” the court makes clear that reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter. This plain language in *North American Container* indicates that the recapture rule is avoided if the added limitations are a materially narrowing in respects other than the broader aspects relating to surrendered subject matter.

In *Pannu*, the Federal Circuit described the second step of the recapture rule analysis as determining “whether the broader aspects of the reissued claim related to surrendered subject matter.” 258 F.3d at 1371, 59 USPQ2d at 1600 (quoting *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164). With regard to the third step, the court stated: “Finally, the Court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.” *Id.* (emphases added), citing for authority *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. As in *North American Container*,

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

the language “materially narrowed in other respects” relates for comparison back to the earlier recited “broader aspects of the reissued claim” (i.e., surrendered subject matter). Again, modification of “materially narrowed” with the phrase “in other respects” clarifies that reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter.

Similarly, in *Hester Indus.*, the Federal Circuit determined that “surrendered subject matter - i.e., cooking other than solely with steam and with at least two sources of steam – has crept into the reissue claims [because] [t]he asserted reissue claims are unmistakably broader in these respects.” 142 F.3d at 1482, 46 USPQ2d at 1649. Immediately after making this determination, the court then stated: “Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects.” *Id.* (emphases added). Yet again, the language “materially narrowed in other respects” relates for comparison back to the earlier recited language “[t]he asserted reissue claims are unmistakably broader in these respects.” It follows that *Hester Indus.* also makes clear that a reissue claim will

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter.

There is a reason the Federal Circuit has repeatedly assessed recapture rule avoidance in terms of whether the reissue claims were materially narrowed in respects other than the broader aspects relating to surrendered subject matter. The reason involves the purpose served by permitting the recapture rule to be avoided under certain circumstances. This purpose is described in *Hester Indus.* as follows:

[T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

142 F.3d at 1482-83, 46 USPQ2d at 1649-50.

As explained in *Hester Indus.*, the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention. Because recapture rule avoidance requires the reissue claim to be materially narrowed in an overlooked aspect of the invention, this material



Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

narrowing must be in respects other than the broader aspects relating to surrendered subject matter. Stated differently, a material narrowing in an overlooked aspect cannot possibly relate to surrendered subject matter since this subject matter, having been claimed and then surrendered during original prosecution, could not have been overlooked.

In *Pannu*, the Federal Circuit stated that “[t]he narrowing aspect of the claim on reissue ... was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means [, and] [t]herefore, the reissued claims were not narrowed in any material respect compared to their broadening.” 258 F.3d at 1372, 59 USPQ2d at 1600-01. If read in a vacuum, this statement might appear to support a contrary result to our analysis. However, the court’s opinion in general and this statement in particular must be read, not in a vacuum but, in light of the facts of the case on appeal.

The reissued claim in *Pannu* was narrowed by requiring the snag resistant means to be “at least three times greater” than the width of the haptics and by requiring the snag resistant means to be “substantially coplanar” with the haptics. 258 F.3d at 1372, 59 USPQ2d at 1600. As revealed in the underlying District Court decision, these same or similar limitations were present in claims throughout

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

prosecution of the original patent application. *Pannu v. Storz Instruments, Inc.*, 106 F. Supp. 2d 1304, 1308 (S.D Fla. 2000). For this reason, the District Court held that the recapture rule had not been avoided because the narrowing limitations were not overlooked aspects of the invention and did not materially narrow the claim. *Id.*, 106 F. Supp 2d at 1308-09, citing for authority *Hester Indus.*, 142 F.3d at 1483, 45 USPQ2d at 1650 and *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1165.

This factual background more fully illuminates the Federal Circuit's determination in *Pannu* that the reissued claims were not narrowed in any material respect compared with their broadening. This determination is not based on the fact that the narrowing limitations of the reissue claims were unrelated to their broadening. Rather, it is based on the fact that these same or similar limitations had been prosecuted in the original patent application and therefore were not overlooked aspects of the invention and did not materially narrow the reissue claims.

The reissue claims in *Clement* were both broader and narrower in aspects germane to a prior art rejection. 131 F.3d at 1470, 45 USPQ2d at 1165. However, the narrower limitation recited in the *Clement* reissue claims ("at least 59 ISO in the final pulp"; *see* clause (e) of reissue claim 49) also was recited in the patent

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

claims (*see* clause (f) of patent claim 1). 131 F.3d at 1470, 1474, 45 USPQ2d at 1165, 1169. Therefore, the narrowing limitation of *Clement*, like *Pannu*, was not overlooked during original prosecution and did not materially narrow the reissue claim.

Finally, in *Mentor*, each of the limitations added to the reissue claims were thoroughly analyzed and determined to not be materially narrowing because the same or similar features were in the patent claims or the prior art. *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525-26. It follows that the reissue claims of *Mentor*, like those of *Pannu* and *Clement*, failed to avoid the recapture rule because they had been broadened to include surrendered subject matter but had not been narrowed in any material respect.

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

(1) which had not been claimed and thus were overlooked during

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

prosecution of the original patent application;<sup>7</sup> and  
(2) which patentably distinguish over the prior art.

(13)  
*Non-relevance of “intervening rights”*

We have not overlooked a possibility that an argument might be made that the so-called intervening rights provision relating to reissues makes jurisprudence on the doctrine of equivalents presumption inapplicable to reissue recapture rules. Our answer as to the argument is similar to the answer given by the Federal Circuit in *Hester* with respect to whether the doctrine of equivalents surrender principles have any applicability to reissue surrender principles. *Hester* squarely held that they do. Moreover, mixing “intervening rights” with “surrender” is like mixing apples with oranges or putting the cart before the horse. A patentee seeking a reissue claim which is barred by recapture is not entitled to a reissue patent under 35 U.S.C. § 251. If there is no reissue patent, there can be no intervening rights.

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<sup>7</sup> For a patent containing only apparatus claims, it might be argued that reissue method claims cannot involve surrendered subject matter where no method claim was ever presented during prosecution of the patent. However, surrender is not avoided merely by categorizing a claimed invention as a method rather than an apparatus. It is the scope of a claimed invention, not its categorization, which determines whether surrendered subject matter has crept into a reissue claim.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(14)  
*Public Notice*

We believe that any recapture analysis must be bottomed principally on a “public notice” analysis which can occur only after a record becomes “fixed.” In the case of a patent, the “claims” and the “prosecution history” become fixed at the time the patent is issued--not during “fluid” patent prosecution where claims and arguments can change depending on the circumstances, *e.g.*, prior art applied and amendments to claims. It is from a fixed perspective that the public (not the patentee) must make an analysis of what the patentee surrendered during prosecution. Moreover, an Appellant (not the public) controls what amendments and arguments are presented during prosecution. When an amendment or argument is presented, it is the Appellant that should be in the best position to analyze what subject matter (*i.e.*, territory to use the Supreme Court’s language) is being surrendered (or explain why the reissue claims are materially narrowed).

Our belief is supported by what appears to be dicta in *MBO Laboratories, Inc. v. Becton, Dickinson & Company*, No. 2006-1062, slip. op. at 12-13 (Fed. Cir. Jan. 24, 2007):

The recapture rule is a limitation on the ability of patentees to broaden their patents after issuance. . . . Section 251 is “remedial in nature,

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

based on fundamental principles of equity and fairness, and should be construed liberally.” However, the remedial function of the statute is limited. Material which has been surrendered in order to obtain issuance cannot be reclaimed via Section 251: . . . It is critical to avoid allowing surrendered matter to creep back into the issued patent, since competitors and the public are on notice of the surrender and may have come to rely on the consequent limitations on claim scope. . . . (“[T]he recapture rule . . . ensur[es] the ability of the public to rely on a patent’s public record.”). The public’s reliance interest provides a justification for the recapture rule that is independent of the likelihood that the surrendered territory was already covered by prior art or otherwise unpatentable. The recapture rule thus serves the same policy as does the doctrine of prosecution history estoppel: both operate, albeit in different ways, to prevent a patentee from encroaching back into territory that had previously been committed to the public. (citations omitted.)

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

B. *The Prima Facie Case*

(1)  
*Examiner's Rejection*

Our Findings of Fact 29-34 set out the basis upon which the Examiner originally made a recapture rejection in the Final Office Action. As noted in Finding of Fact 35, the record supports the Examiner's findings.

Basically, in the application which matured into the patent now sought to be reissued, the Examiner rejected originally filed independent claim 1 over the prior art. Appellant proceeded to re-write application claim 1 by adding new limitations. Amended application claim 1 issued as patent claim 1.

The Examiner made four points in Findings of Fact 29-34:

- (1) when faced with a rejection in the original application Appellant made three *significant* amendments (See Finding of Fact 29);
- (2) when faced with a rejection in the original application Appellant made three *insignificant* amendments (See Finding of Fact 30);
- (3) when faced with a rejection in the original application Appellant made extensive *significant* arguments (See Finding of Fact 31 and Findings of Fact 14-19);

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(4) reissue claims 14-100 are broader than the original patent claims with respect to almost all the limitations added and arguments made to overcome the rejection (See Findings of Fact 32-34).

The Examiner's accurate factual analysis demonstrates that the Examiner has made out a prima facie case of recapture consistent with the test set forth in *Clement* and amplified in *Hester*.

Further, we hold that with respect to the Examiner's theory of the rejection, the burden of persuasion now shifts to the Appellant to establish that the *prosecution history* of the application, which matured into the patent sought to be reissued, establishes that a surrender of subject matter did not occur or that the reissued claims were materially narrowed.

### C. *Appellant's Response*

#### (1) *Abduction and Lithotomy Limitation*

With respect to independent claims 14, 24, 48, 72, 81, and 91, Appellant argues at pages 6, 12, 17, 22, 26, and 31 of the Brief, that the broadening with respect to the abduction and lithotomy axes is not a material broadening (does not



Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

relate to surrendered subject matter) and does not violate the recapture rule. We agree.

Contrary to the Examiner's position (Answer 4) this limitation was not added by amendment. This limitation was present in the claims as originally filed. Further, we find no argument in the prosecution history that this limitation distinguishes over the prior art. We conclude that Appellant has rebutted any prima facie case of recapture based on this limitation.

(2)  
*Longitudinal Axis Limitation*

With respect to independent claims 14, 24, 48, 72, 81, and 91, and dependent claims 16 and 94, Appellant argues at pages 6, 11, 12, 17, 22, 27, 32, and 35 of the Brief, that the broadening with respect to the longitudinal axis is not an impermissible broadening (does not relate to surrendered subject matter) and does not violate the recapture rule. We agree as to independent claims 24, 48, 72, and 81. We agree as to dependent claims 16 and 94. We disagree as to independent claims 14 and 91.

Appellant correctly points out that this feature is explicitly recited or inherent to each of claims 16, 24, 48, 72, 81, and 94. As to these claims, we

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

conclude that Appellant has rebutted any prima facie case of recapture based on this limitation.

As to claims 14 and 91, Appellant argues, that since the preferred embodiment of the specification includes this limitation, these claims (which cover the preferred embodiment) are not broadened in this aspect. Appellant is asking this Board to read limitations into the claims from the specification. We decline to do so.

We determine the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). However, the court cautioned against reading limitations into the claim from the specification:

We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed.Cir.2004) ( “Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using ‘words or expressions of manifest

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

exclusion or restriction.’ ”); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed.Cir.2002).

*Id.*, 367 F.3d at 1369, 70 USPQ2d at 1834.

As to claims 14 and 91, we conclude that Appellant has not rebutted the Examiner’s prima facie showing of recapture based on this limitation.

(3)

*First and Second Axes Transverse to Longitudinal Axis Limitation*

With respect to independent claims 14, 24, 48, 72, 81, and 91, Appellant argues at pages 7, 12, 17, 22, 27, and 32, of the Brief, that the broadening with respect to the transverse relationship of the first and second axes with the longitudinal axis is not an impermissible broadening (does not relate to surrendered subject matter) and does not violate the recapture rule. We disagree.

Appellant argues that since the preferred embodiment of the specification includes this limitation, these claims (which cover the preferred embodiment) are not broadened in this aspect. Again, Appellant is asking this Board to read limitations into the claims from the specification, and again we decline to do so for the reasons previously set forth.

With respect to dependent claims 16, 33, and 62, Appellant concludes without further explanation at pages 11, 16, and 21, of the Brief, that this limitation

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

is not dropped from the claims and Appellant's arguments during prosecution do not amount to surrender. Such conclusions, without explanation, are of minimal evidentiary value and do not persuade us that the Examiner has erred.

We conclude that Appellant has not rebutted the Examiner's prima facie showing of recapture based on this limitation.

(4)

*Mounting Device Having a First Axis Limitation*

With respect to independent claims 14, 24, 48, 72, 81, and 91, Appellant argues at pages 7, 13, 18, 22, 27, and 32, of the Brief, that the broadening with respect to the mounting device having a first axis is not an impermissible broadening (does not relate to surrendered subject matter) and does not violate the recapture rule. We agree.

This limitation was not added by amendment. Rather, this limitation was present in the claims as originally filed. Further, we find no argument in the prosecution history that this limitation distinguishes over the prior art. We conclude that Appellant has rebutted any prima facie case of recapture based on this limitation.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

(5)  
*Simultaneously Selectively Clamping And Releasing Said  
Support Device About The First And Second Axes*

With respect to independent claims 14, 24, 48, 72, 81, and 91, Appellant argues at pages 7, 13, 18, 23, 27, and 32, of the Brief, that the broadening with respect to the simultaneously selectively clamping and releasing said support device about the first and second axis is not an impermissible broadening (does not relate to surrendered subject matter) and does not violate the recapture rule. We disagree.

Appellant argues that the term “simultaneously” “refers to the ability to both clamp and release” (Br. 7). As the Examiner correctly points out (Finding of Fact 39) and as we find in Appellant’s Specification (U.S. Patent 5,802,641, col. 3, ll. 62-64), the “simultaneously” refers to releasing in plural dimensions (or axes) at the same time or clamping in plural dimensions at the same time. Appellant’s erroneous argument fails to persuade us that the Examiner erred.

Also, Appellant argues that since the preferred embodiment of the specification includes this limitation, these claims (which cover the preferred embodiment) are not broadened in this aspect. Again Appellant is asking this

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

Board to read limitations into the claims from the specification, and again we decline to do so for the reasons previously set forth.

With respect to dependent claim 78, 85, and 95, Appellant concludes, without further explanation at pages 26, 30, and 35, of the Brief, that this limitation is not dropped from the claims and Appellant's arguments during prosecution do not amount to surrender. Such conclusions, without explanation, are of minimal evidentiary value and do not persuade us that the Examiner has erred.

We conclude that Appellant has not rebutted the Examiner's prima facie showing of recapture based on this limitation.

(6)

*Support Device Fixed from Rotation About The Longitudinal Axis*

With respect to independent claims 14, 24, 48, 72, 81, and 91, Appellant argues at pages 7, 13, 18, 23, 27, and 32, of the Brief, that the broadening with respect to the support device being fixed from rotation about the longitudinal axis is not an impermissible broadening (does not relate to surrendered subject matter) and does not violate the recapture rule. We disagree.

Appellant contends that the Examiner's comparison of this limitation to the now claimed new limitation of "the support device is clamped against movement

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

about the second plurality of axes” “is confusing and . . . does not explain how the comparison is relevant to the recapture issue” (Br. 7). Appellant then immediately concludes that “the support device is fixed to the clamping device” because in-part the claim recites “the support device is clamped against movement about the second plurality of axes” (Br. 7-8). Since Appellant himself points to the new limitation in an attempt to show the deleted limitation is still present in the claim, this rebuts Appellant’s contention that he was confused by the Examiner comparing this new limitation to the deleted limitation.

As to the “fixed from rotation . . .” limitation, we find nothing in the cited sections (Br. 8) of the reissue claims or elsewhere in the reissue claims that includes this limitation. Appellant argues that since the preferred embodiment of the specification includes this limitation, these claims (which cover the preferred embodiment) are not broadened in this aspect. Again Appellant is asking this Board to read limitations into the claims from the specification, and again we decline to do so for the reasons previously set forth.

With respect to dependent claims 85 and 95, Appellant concludes, without further explanation at pages 30 and 35, of the Brief, that this limitation is not dropped from the claims and Appellant’s arguments during prosecution do not

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

amount to surrender. Such conclusions, without explanation, are of minimal evidentiary value and do not persuade us that the Examiner has erred.

We conclude that Appellant has not rebutted the Examiner's prima facie showing of recapture based on this limitation.

(7)  
*Simultaneously Selectively Clamping And Releasing the  
Support Device And a Mounting Device*

With respect to independent claims 14, 24, 48, 72, 81, and 91, Appellant opines and concludes at pages 7, 13, 19, 23, 28, and 33, of the Brief, that the broadening with respect to the claim feature *simultaneously selectively clamping and releasing said support device and mounting device* is not an impermissible broadening (does not relate to surrendered subject matter) and does not violate the recapture rule.

Appellant presents no argument to rebut the Examiner's prima facie case as to this point. Rather, Appellant merely states conclusions that are not supported by any explanation. For example, Appellant does not explain why this Board should adopt his conclusion that "[t]here is no material difference between what is allegedly removed and the corresponding language of claim 14" (Br. 8). Such



Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

conclusions, without explanation, are of minimal evidentiary value and do not persuade us that the Examiner has erred.

With respect to dependent claim 85 and 95, Appellant concludes, without further explanation at pages 30 and 35, of the Brief, that this limitation is not dropped from the claims and Appellant's arguments during prosecution do not amount to surrender. Such conclusions, without explanation, are of minimal evidentiary value and do not persuade us that the Examiner has erred.

We conclude that Appellant has not rebutted the Examiner's prima facie showing of recapture based on this limitation.

(8)

*Appellant's Prosecution Arguments*

With respect to independent claims 14, 24, 48, 72, 81, and 91, Appellant argues at pages 8-11, 14-16, 19-21, 24-25, 28-30, and 33-35, of the Brief, that "Appellant's arguments in the amendment of February 17, 1998 filed during prosecution of parent application serial No. 813,708 filed March 7, 1977 are relatively brief." Appellant goes on to argue "the argument for patentability to be considered in recapture is limited to [the] two axis release irrespective of limitations alleged to have been dropped in this reissue." Appellant then

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

repetitively (42 times) makes arguments and conclusions with respect to  
“Appellant’s arguments during prosecution of the ‘641 patent.”

At no point in these sixteen pages does Appellant ever inform this Board of exactly which “arguments in the amendment,” “argument for patentability,” or “arguments during prosecution” Appellant is referencing. We will not speculate as to which arguments in the parent are being referenced. Nor does Appellant ever inform this Board why he concludes that such arguments in the parent would not be viewed by an objective observer as a surrender generating argument. *Kim*, 465 F.3d at 1323, 80 USPQ2d at 1502.

We conclude that these Appellant arguments have not rebutted the Examiner’s prima facie showing of recapture.

(9)

*Supporting Device Moving Jointly About First And Second Axes Limitation*

With respect to this limitation argued in the parent (See the Findings of Fact 19 *supra* with respect to Appellant’s arguments regarding claim limitation (1)) and relied on by the Examiner (Findings of Fact 31), Appellant has presented no rebuttal arguments in this brief.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

We conclude that with respect to this limitation Appellant has not rebutted the Examiner's prima facie showing of recapture.

(10)

*First And Second Axes are Transverse to Each Other Limitation*

With respect to this limitation argued in the parent (See the Findings of Fact 19 *supra* with respect to Appellant's arguments regarding claim limitation (4)) and relied on by the Examiner (Findings of Fact 31), Appellant has presented no rebuttal arguments in this brief.

We conclude that with respect to this limitation Appellant has not rebutted the Examiner's prima facie showing of recapture.

## V. CONCLUSION

Appellant's arguments have not rebutted the presumption, upon which the Examiner's rejection is based, i.e., that at the time of the amendment an objective observer would reasonably have viewed the subject matter of the narrowing amendment and limitations argued in the parent as having been surrendered.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

## VI. DECISION

Upon consideration of the record, and for the reasons given, we affirm the rejection of claims 14-100 under 35 U.S.C. § 251 based on recapture.

AFFIRMED

ELD

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

Bradley R. Garris, Administrative Patent Judge, concurring:

For the reasons expressed in the panel opinion above, the record of this appeal establishes a prima facie case of recapture which the Appellant has failed to successfully rebut. Therefore, I fully agree with the decision to affirm the § 251 rejection of claims 14-100 based on recapture.

I write separately only to express disagreement with certain statements, which are merely dicta, in the above opinion.

Specifically, page 25 contains the statement "the Subset (3)(a) rationale of the *Eggert* majority (1) is not consistent with the rationale of the Federal Circuit in *North American Container* and (2) should no longer be followed or be applicable to proceedings before the USPTO." I do not consider the aforementioned rationale of *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003) to be inconsistent with the rationale of *North American Container, Inc. v. Plastipak Packaging, Inc.*, 413 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005). The fact that an added claim limitation was considered to be surrendered in *North American Container* but not in *Eggert* is because these cases involved different facts which evinced surrender in the former but not the latter.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

Additionally, the opinion above proposes that surrendered subject matter in Subset (3)(a) of *Clement* is, not only the subject matter of an application claim which was amended or canceled but also, "on a limitation-by-limitation basis, the territory falling between the scope of (a) the application claim which was canceled or amended and (b) the patent claim which was ultimately issued" (page 26). Whether this "territory" may be properly considered surrendered subject matter depends on the factual evidence relevant to the surrender issue. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482, 46 USPQ2d 1641, 1649 (Fed. Cir. 1998) is an example of a case in which factual evidence supported a determination that the aforementioned "territory" included surrendered subject matter. In contrast, *In re Richman*, 409 F.2d 269, 274-275, 161 USPQ 359, 363 (CCPA 1969) is an example of a case in which the court expressly stated that this "territory" did not contain surrendered subject matter.

Notwithstanding my disagreement with these aspects of the panel opinion, I reiterate that the record of this appeal establishes a prima facie case of recapture based on surrender which is evinced by prosecution argument. *Hester*, 142 F.3d at 1482, 46 USPQ2d at 1649. Therefore, I join with my other panel members in affirming the § 251 rejection of the reissue claims on appeal.

Appeal 2006-1865  
Application 09/660,433  
Patent 5,802,641

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